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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,339	03/03/2004	Richard B. Klein	9399-3	4548

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EXAMINER	
SCHLIENTZ, NATHAN W	
ART UNIT	**PAPER NUMBER**
1616	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/792,339	KLEIN ET AL.	
	Examiner	Art Unit	
	Nathan W. Schlientz	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Claims 1-22 are pending and are thus examined herein on the merits for patentability. No claim is allowed at this time.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 22 recites the limitation "said strain" in the last line. There is insufficient antecedent basis for this limitation in the claim.

35 U.S.C. § 101 Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states, "whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

1. Claims 1-6 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 13-17 and 23 of prior U.S. Patent No. 7,220,761. This is a double patenting rejection.

Nonstatutory-type Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 7-8 and 11-14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-5, 24 and 28-29 of U.S. Patent No. 7,220,761. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a method for controlling/combating fungi and/or bacteria by administering a compound of instant claim 1 and claim 4 of the 761' application. Although the target for treatment is not

identical in both sets of claims, they are overlapping in scope. For instance, the instant claims are drawn to a method for controlling fungi and/or bacteria, whereas the '465 claims are drawn to a method for combating fungi and/or bacteria in numerous substrates listed in claim 4, or an industrial product as in claim 5. Therefore, a generic teaching of controlling fungi and/or bacteria overlaps in scope with combating fungi and/or bacteria in substrates or industrial products. Therefore, the scopes of the copending claims are overlapping and thus they are obvious variants of one another.

2. Claims 1 and 4-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-7, 9-10, 16-17, 19-22 and 24-25 of copending Application No. 10/792,465. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a method for treating a bacterial or fungal infection comprising administering a composition comprising the structure of instant claim 1 and claim 6 of the '465 application. Although the target for treatment is not identical in both sets of claims, they are overlapping in scope. For instance, the instant claims are drawn to a method for controlling fungi and/or bacteria, whereas the '465 claims are drawn to a method for treating an infection, which comprises bacterial and fungal infections. Also, instant claim 5 is drawn to the method for controlling fungi and/or bacteria after fungal growth occurs (i.e. fungal infection). Therefore, the scopes of the copending claims are overlapping and thus they are obvious variants of one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 27, 29, 31-32, 34-36. 38-39, 45 and 47-48 of copending Application No. 11/745,111, in view of U.S. Application Publication No. 2002/0044962. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a method of controlling/combating fungi and/or bacteria through administering a compound of instant claim 1. The instant claims do not claim the compound being encapsulated. However, the '962 publication teaches encapsulation of active agents, including antifungal agents, provides extended or controlled release of the active (Abstract; and paragraph [0127]. Therefore, it would have been *prima facie* obvious for a person of ordinary skill in the art at the time of the instant invention to encapsulate the antifungal compound of the instant invention in order to control the release of the active compound, as reasonably suggested by the '962 publication.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 9-10 and 15-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-19 and 23-24 of U.S. Patent No. 7,220,761 in view of U.S. Patent No. 4,105,793. Although the conflicting

claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a method of controlling fungi and/or bacteria through administering a compound of instant claim 1. The instant claims are drawn to a method for treating agricultural fungal and/or bacterial infections, whereas the '761 patent is drawn to treating sheetrock, lumber, decking, flooring, roofing, carpets, wallpaper, paneling, cloth, caulking, mortar, tiles, grout, fasteners, adhesives, paint, coatings, sealants and stucco. However, the '793 patent teaches fungicidal compositions useful for treating fungal infestation of wood, paper, leather, tobacco, paints, adhesives, textiles, cosmetics, etc. are preferentially utilized in agriculture in the control of plant pathogens as by application to the foliage or growing crops or in the formulation of seed coatings (column 2, lines 21-28). Therefore, it would have been *prima facie* obvious for a person of ordinary skill in the art at the time of the instant invention to treat fungal and/or bacterial infestation of agricultural crops or seeds with the compound taught by the '761 patent, as reasonably suggested by the '793 patent.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan W. Schlientz whose telephone number is 571-272-9924. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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